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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,171	10/31/2000	Aman Safaei	W1200-00034	9592

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EXAMINER

RADA, ALEX P

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/703,171

Applicant(s)

SAFAEI ET AL.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 92-121 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-15, 17-25, 92-97, 100-106 and 108-116 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 16, 26-30, 98, 99, 107 and 117-121 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 3. 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Response to Amendment*

In response to the amendment filed April 29, 2003 in which the applicant has amended claims 1, 11, 18, 20, 92, 102, 109, and 111 and claims 1-30 and 92-121 are pending in this office action.

### *Claim Rejections - 35 USC § 102*


1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 9-13, 92-97, and 100-104 are rejected under 35 U.S.C. 102(e) as being anticipated by Brenner '981.

3. Brenner discloses a means for providing race entry data through a computer network to a user terminal having a listing of tracks, scheduled races, *future dates (figures 1 and 11)*, a means for providing race program data through the computer network to a user terminal, a means for providing live odds through a computer network, and a means for updating through a computer network (summary) as recited in claims 1 and 92; the race program data having program number (not shown) and post position for each current entry in each race (summary) as recited in claims 2 and 93; the race entry data further having morning line odds (column 18, line 51-61) as recited in claims 3 and 94; the entry data further having an original jockey and trainer for each entry and



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current entry as recited in claims 4 and 95; a means for providing a list of at least one past performance, at least one handicapping , or at least one tip selection or combination to a user on a user terminal (summary) as recited in claims 5 and 96; a means for charging a credit card of the user, a wagering account of the user, or a promotional account of the user (column 20, line 20-34) as recited in claim 6 and 97; a means for providing results data for currently scheduled races to a user terminal through the computer network after currently scheduled races have been made official and the results include finish order of entries from races and payoff for the entries on the user terminal (summary) as recited in claims 9 and 100; a means for providing a listing of a plurality of tracks and weather conditions for the tracks displayed on the user terminals (column 6, line 51 – 58) as recited in claims 10-12 and 101-103; a means for providing race contest new articles to the user on a user terminal (column 9, lines 11-31) as recited in claims 13 and 104.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14-15, 17-25, 105-106, and 108-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner '981 in view of Wu '756.

6. Brenner discloses the claimed invention as discussed above except for prompting a user to view contents news articles selected by a user and displayed on a user terminal (column 9, lines 11-31) as recited in claims 14 and 105; A means for prompting a user for displaying post

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time for currently scheduled races and means for causing post times for currently scheduled races to be expressed in a time zone displayed on user terminal (figure 35 and column 22, line 47 – column 23, line 5) as recited in claim 15 and 106; A means for providing a board having entries including a horse, jockey, or trainer, and a means for providing selected result identifying races including a horse, jockey, or a trainer entries (figures 20-23) as recited in claims 17 and 108; A means for prompting the user to select a horse, a jockey, or a trainer for providing statistical data for horse, jockey, or trainer selected by user on a user terminal (column 14, line 61 – column 15, line 3) as recited in claims 19 and 110; A means for providing a race board on a user terminal having a listing of a plurality of races scheduled for a predetermined period of time and prompting a user at least one race characteristic (post-time) on a user terminal (column 9, lines 41-64) as recited in claims 20, 23, 111, and 114. Brenner does not expressly disclose a means for causing the search result to be organized by a plurality of headings as recited in claims 18 and 109; the race characteristic includes a plurality of headings as recited in claims 21 and 112; a means for prompting user to organize search result according to a race characteristics and a means for causing the search results to be organized by a race characteristics select by the user on a user terminal as recited in claims 22 and 113; a means for providing a race board on a user terminal having a listing of a plurality of races scheduled for a predetermined period of time, prompting the user to organized the listing by at least one race characteristic and the a means for causing the listing to be organized by race characteristics selected by the user on a user terminal as recited in claims 23 and 114; the race characteristic include a plurality of headings as recited in claims 24 and 115; a means for prompting the user to search the listing for race having at least

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one race characteristic and a means for causing the listing to be searchable for races having a race characteristic selected by the user on a user terminal as recited in claims 25 and 116.

Wu teaches a database with the capability of searching and organizing according to keywords and topical searches for given information. By having a database with the ability to search and organize a plurality of given and updated information, one of ordinary skill in the art would be able to customize information to a users preference. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicants invention was made to modify Brenner to include a means for causing the search result to be organized by a plurality of headings, having the race characteristic includes a plurality of headings, a means for prompting user to organize search result according to a race characteristics and a means for causing the search results to be organized by a race characteristics select by the user on a user terminal, a means for providing a race board on a user terminal having a listing of a plurality of races scheduled for a predetermined period of time, prompting the user to organized the listing by at least one race characteristic and the a means for causing the listing to be organized by race characteristics selected by the user on a user terminal, a means for prompting the user to search the listing for race having at least one race characteristic and a means for causing the listing to be searchable for races having a race characteristic selected by the user on a user terminal as taught by Wu. To do so would provide the capability to look for and customize different information based on a user's preference.

***Response to Arguments***

7. Applicant's arguments filed April 29, 2003 have been fully considered but they are not persuasive.

Applicant contends that the Brenner '981 reference does not provide any racing data that include race entry data for races at a future date and the data transmitted through a computer network.

In response to applicant's arguments Brenner does show racing data that include race entry data for races at a future date. In figures 10 and 11, when a user selects a specific racetrack, that specific racetrack is displayed on the user's terminal. A menu is also displayed having the current date, time, and the given future race data for that specific racetrack. Webster's dictionary defines date as, the time at which an event occurs. The posted times in figure 10 display the different future race dates. Further, Brenner also has the capability of providing race data and odds to a user terminal via a computer network (column 19, line 38 - column 20, line 5). Figure 29 provides a user terminal (computer terminal) connected by a communication line (390) e.g. modem connected to a network (392) for communications for transaction data (wagers placed, account information. etc.).

In response to applicant's argument that Wu '756 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Wu reference was used to provide the teachings of a searchable database for a given query. Brenner discloses the topical

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information needed for a user to place wagers on given races. Brenner does not disclose the search capabilities for optimizing the given data for optimal betting strategy of a given horse, track, jockey, etc. By having a database with the ability to search and organize a plurality of given and updated information, one of ordinary skill in the art would be able to customize information to a users preference.

*Allowable Subject Matter*

Claims 7-8, 16, 26-30, 98-99, 107, and 117-121 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

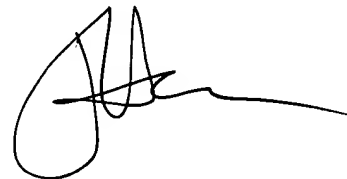
A court '019 discloses a method and apparatus for facilitating electronic commerce between suppliers of prediction and consumer of predictions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

*APR*  
apr  
July 8, 2003

A handwritten signature in black ink, appearing to be 'JH' followed by a long horizontal stroke.

JESSICA HARRISON  
PRIMARY EXAMINER